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TRANSMITTAL FORM

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Total Number of Pages in This Submission

22

Application Number

09/578,672

Filing Date

5/25/2000

First Named Inventor

Cynthia Donovan

Art Unit

2145

Examiner Name

Mirza, Adnan

Attorney Docket Number

1112

ENCLOSURES (Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment / Reply



After Final



Affadavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)



Response to Missing Parts/
Incomplete Application



Response to Missing Parts
under 37 CFR 1.52 or 1.53



Assignment Papers
(for an Application)



Drawing(s)



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Petition



Petition to Convert to a
Provisional Application



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After Allowance Communication
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Appeal Communication to Board
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Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)



Proprietary Information



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Charles E. Gottlieb

Signature

Date

December 20, 2006

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FEE TRANSMITTAL for FY 2005

Effective 10/01/2003. Patent fees are subject to annual revision

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 500

Complete if Known

Application Number	09/578,672
Filing Date	5/25/2000
First Named Inventor	Cynthia Donovan
Examiner Name	Mirza, Adnan
Art Unit	2145
Attorney Docket No.	1112

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number: 07-1738
Deposit Account Name: Charles E. Gottlieb

The Director is authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	1000	2001	500	Utility filing/search/exam	
1002	350	2002	175	Design filing/search/exam	
1003	550	2003	275	Plant filing/search/exam	
1004	790	2004	395	Reissue filing/search/exam	
1005	200	2005	100	Provisional filing fee	
SUBTOTAL (1) (\$)					

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims: 31 - 31** = X =
Independent Claims: 3 - 3** = X =
Multiple Dependent: =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	50	2202	25	Claims in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203	360	2203	180	Multiple dependent claim, if not paid	
1204	88	2204	44	**Reissue independent claims over original patent	
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2) (\$)					

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge-late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2520	1812	2520	For filing a request for ex parte reexamination	
1804	920	1804	920	Requesting publication of SIR prior to Examiner action	
1805	1840	1805	1840	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1020	2253	510	Extension for reply within third month	
1254	1590	2254	795	Extension for reply within fourth month	
1255	1890	2255	1080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	500
1403	1000	2403	500	Request for oral hearing	
1451	1510	1451	1510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1500	2453	750	Petition to revive - unintentional	
1501	1400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1100	2503	550	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					
*Reduced by Basic Filing Fee Paid					
SUBTOTAL (3) (\$)					500

SUBMITTED BY

Name (Print/Type) Charles E. Gottlieb

Signature

Charles E. Gottlieb

Registration No.
(Attorney/Agent)

38,164

(Complete (if applicable))

Telephone

650-328-010014

Date

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Cynthia Donovan, et. al.
SERIAL NO: 09/578,672
FILING DATE: 5/25/2000
TITLE: METHOD AND APPARATUS FOR CONTROLLING ACCESS TO A WEBSITE
GROUP ART UNIT: 2145
ATTY DOCKET NO: 1112
EXAMINER: Mirza, Adnan

CERTIFICATION OF MAILING

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Date: 12/20/2006


Charles E. Gottlieb

THE HONORABLE COMMISSIONER OF PATENTS, ALEXANDRIA, VA 22313

APPEAL BRIEF UNDER 37 C.F.R. 1.192

SIR:

In support of the appeal of the above-referenced case:

12/27/2006 JADD01 00000002 09578672

01 FC:1402

500.00 0P

1. Real Party in Interest.

The real party in interest is Charles Schwab & Co.,
Inc.

2. Related Appeals and Interferences.

There are no related appeals and interferences.

3. Status of Claims.

All claims are rejected. Claims 1, 14, and 27 are
being appealed.

4. Status of Amendments.

Amendments A-E were filed and entered in the
application.

5. Summary of Claimed Subject Matter.

Claim 1 recites, "A method of processing a first
request for web page, comprising:"

"receiving the first request for the web page; and"
(page 39, line 18)

"transmitting, to a device from which the first
request was received, at least one command to send a
second request for the web page, and a first timestamp."
(page 41, lines 3-11)

Claim 14 recites, "A computer program product comprising a computer useable medium having computer readable program code embodied therein" (page 9, lines 2-4) "for processing a first request for web page, the computer program product comprising:"

"computer readable program code devices" (page 9, lines 2-4) "configured to cause a computer to receive the first request for the web page; and" (page 39, line 18)

"computer readable program code devices" (page 9, lines 2-4) "configured to cause a computer to transmit, to a device from which the first request was received, at least one command to send a second request for the web page, and a first timestamp." (page 41, lines 3-11)

Claim 27 recites, "An apparatus for processing a first request for a web page, the apparatus comprising:"

"a user request router having an input coupled to an apparatus input operatively coupled for receiving the first request," (page 15, lines 16-18; page 16, lines 6-8) "the user request router for providing at an output a signal responsive to the first request received at the user request router input; and" (page 20, lines 15-16)

"a cookie/applet generator having an input coupled to the user request router output for receiving the signal,"

(page 20, lines 15-16) "the cookie/applet generator for providing, to a device from which the first request was received, via a first output coupled to an apparatus output, a first indicator of at least one time to send a second request for the web page." (page 20, lines 16-23; page 18, lines 1-12)

6. Grounds of Rejection to be Reviewed on Appeal.

Examiner rejects claims 1, 14, and 27 under 35 U.S.C. 103(a) as being unpatentable over Christensen and Kavner.

7. Argument.

A. The Claims Are Patentably Distinguishable Over Christensen and Kavner Because Christensen and Kavner Do Not Teach Or Suggest All the Claim Limitations, Either Alone or In Combination.

1. The Claims Are Patentably Distinguishable Over Christensen and Kavner Because Christensen and Kavner Do Not Show the Claim Feature of Transmitting, to a Device from Which a First Request for a Web Page Was Received, At Least One Command to Send a Second Request for the Web Page.

Claim 1 recites, "receiving the first request for the web page; and transmitting, to a device from which the

first request was received, at least one command to send a second request for the web page".

Claim 14 recites, "computer readable program code devices configured to cause a computer to receive the first request for the web page; and computer readable program code devices configured to cause a computer to transmit, to a device from which the first request was received, at least one command to send a second request for the web page".

Claim 27 recites, "the cookie/applet generator for providing, to a device from which the first request was received, via a first output coupled to an apparatus output, a first indicator of at least one time to send a second request for the web page."

Examiner argues in the final Office Action, page 2, second paragraph, that Christensen discloses a method of processing a first request for a web page, and that Kaplan discloses issuing a GET request from a browser to a server, where the GET request includes an If-Modified-Since tag containing a timestamp of a web page in the browser's cache. Examiner further argues on page 7, lines 8-9 that one of ordinary skill in the art at the time of the

invention can interpret this GET request as a command to send a request if a certain value changes.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Cited in M.P.E.P. 2143.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d

1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

Each of the appealed claims provide a feature wherein at least one command or indicator to send a second request for a web page is provided to a device requesting the web page. On page 2 of the final Office Action, Examiner admits that Christensen "did not go in details of" this feature, but Examiner appears to argue that Kavner's GET <resource> request and/or connect command is equivalent to transmitting, to a device requesting a web page, a command to send a second request for the web page. This is not the case.

The GET <resource> request described by Kavner is sent from a browser, which runs on a client, to a server (Col. 4, lines 22-24), and is the means by which the browser requests a web page from the server (Col. 4, lines 11-14). However, Kavner never teaches or suggests that the server transmits a command back to the client to send a second

request for the web page. According to Kavner, the server responds to the GET <resource> request by either providing the web page or providing a Not Modified code, which indicates that the version of the page in the browser's cache is the most current version (Col. 4 lines 25-32). Neither of these responses comprise transmitting or providing, to the device requesting the web page, a command or indication to send a second request for the web page, as claimed.

Examiner notes on page 7 of the final Office Action, lines 7-8, that the claim language doesn't disclose that the second request comes from the same device. Applicants do not argue that the claims cover how the device responds to the command. However, the sending of the command or indication is clearly specified in the claims, and it is also clearly specified that the command to send a second request is transmitted to the same device that requested the web page. The references do not show this feature as noted above.

Examiner also argues on page 7 of the final Office Action, lines 2-3, that the re-request command described in the specification "is different from the sending a second request according to the claim language". This is not

correct. A re-request is a request that follows a first request: therefore it is a second request. Similarly, a command to send a re-request is the same as a command to send a second request. Neither Kavner nor Christensen teach or suggest transmitting such a command to the device requesting the web page, or providing to the device an indicator that the second request should be sent.

Moreover, such a command is not inherently part of either Kavner or Christensen, because in both Kavner and Christensen the request for the web page is fulfilled immediately, either using resources provided by the web server (Christensen Col. 5 lines 3-5; Kavner Col. 4 lines 25-28) or using cached resources (Christensen Col. 4 line 63-Col. 5 line 1; Kavner Col. 4 lines 28-31). Therefore, the inventions described by Kavner and Christensen both operate without the step of providing a command or indicator to the browser that a second request should be sent.

Because not all the claim limitations are taught or suggested by Kavner or Christensen, either expressly or inherently, alone or in combination, Examiner has not made a *prima facie* case of obviousness, and the 103 rejection should be reversed.

2. Claim 27 Is Patentably Distinguishable Over Christensen and Kavner Because Christensen and Kavner Do Not Show the Claim Feature of a Cookie/Applet Generator for Providing, to a Device from Which the First Request was Received, a First Indicator of at Least One Time to Send a Second Request for the Web Page.

Claim 27 recites, "the cookie/applet generator for providing, to a device from which the first request was received, via a first output coupled to an apparatus output, a first indicator of at least one time to send a second request for the web page."

Examiner argues on page 5 of the final Office Action, in section 14, that the proxy cache cluster described by Christensen would be understood by one of ordinary skill in the art at the time of the invention as a cookie/applet generator, and that Christensen's description of cluster messages delivered using the alert timer comprise a first indicator of at least one time to send a second request for the web page.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be

considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Cited in M.P.E.P. 2143.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

In the final Office Action, Examiner wrote on page 7, final paragraph, "One [of] ordinary skill in the art at the time of the invention knows that proxy is also interpreted as cookie." This is manifestly not correct. *Newton's Telecom Dictionary* (2003: CMP Books) defines a cookie as "a simple text file on your hard disk that has been placed by a web site you visited". A proxy is defined as "an intermediate application program that acts as both a client and a server." Therefore, a proxy is very different from a cookie. Examiner has made no showing to support this assertion.

However, even if Christensen did describe a cookie/applet generator, which he does not, Examiner would still be required to show that the system of Christensen performs all of the functions described in the claim, specifically "providing, to a device from which the first request was received, via a first output coupled to an apparatus output, a first indicator of at least one time to send a second request for the web page" as set forth in claim 27.

On page 8 of the final Office Action, Examiner cites Christensen Col. 10, lines 48-51 as disclosing a sending of the indicator. These lines describe how processor/memory

mechanisms within a proxy cache cluster exchange messages when a configuration change is pending. The following lines specify that this is done "in order to synchronize the members as the cluster forms" (Col. 10 lines 53-54). It is clear that these messages are sent among the members of the proxy cluster, not to the device requesting the web page. Therefore, Christensen does not teach providing to that device an indicator of at least one time to send a second request for the web page. Additionally, as was set forth above, Kavner does not teach or suggest providing such an indicator to that device. Providing such an indicator to that device is not inherently a part of Christensen or Kavner because the inventions described by Christensen and Kavner can operate without the inclusion of any such indicator.

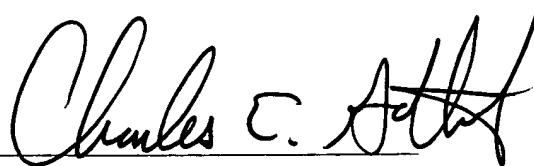
Because not all the limitations of claim 27 are taught or suggested by Kavner or Christensen, either expressly or inherently, alone or in combination, Examiner has not made a *prima facie* case of obviousness, and the 103 rejection of claim 27 should be reversed.

Conclusion

Claims 1, 14, and 27 are patentably distinguishable over the cited references. Favorable action is solicited.

Respectfully Submitted

December 20, 2006

A handwritten signature in black ink, appearing to read "Charles C. Gottlieb", written over a horizontal line.

Charles Gottlieb

Reg. No. 38,164

Innovation Partners

540 University Ave.

Suite 300

Palo Alto, CA 94301

8. Claims Appendix.

1. A method of processing a first request for web page, comprising:

receiving the first request for the web page; and

transmitting, to a device from which the first request was received, at least one command to send a second request for the web page, and a first timestamp.

14. A computer program product comprising a computer useable medium having computer readable program code embodied therein for processing a first request for web page, the computer program product comprising:

computer readable program code devices configured to cause a computer to receive the first request for the web page; and

computer readable program code devices configured to cause a computer to transmit, to a device from which the first request was received, at least one command to send a second request for the web page, and a first timestamp.

27. An apparatus for processing a first request for a web page, the apparatus comprising:

a user request router having an input coupled to an apparatus input operatively coupled for receiving the first request, the user request router for providing at an output a signal responsive to the first request received at the user request router input; and

a cookie/applet generator having an input coupled to the user request router output for receiving the signal, the cookie/applet generator for providing, to a device from which the first request was received, via a first output coupled to an apparatus output, a first indicator of at least one time to send a second request for the web page.

9. Evidence Appendix.

No evidence appendix is being submitted.

10. Related Proceedings Appendix.

There are no related proceedings, therefore Applicants are not submitting a related proceedings appendix.